Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SALIM G. KARA and MARTIN J. PAGEL

Appeal No. 2004-0416
Application No. 08/953,477

ON BRIEF

Before DIXON, GROSS, and MACDONALD, ***Administrative Patent Judges.***

MACDONALD, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 57-74 and 90. All other claims have been canceled.

Invention

Appellants' invention relates to an electronic document transfer system that provides for transmission of documents and printing and delivery in physical form. Appellants' specification at page 2, lines 2-5.

Claim 57 is representative of the claimed invention and is reproduced as follows:

57. A system for delivering information to a selected location from a transmitting location, said system comprising:

a transmission station operable at said transmitting location and adapted to transmit said information to an intermediate location; and

an intermediate station operable at said intermediate location and adapted to receive said information transmitted by said transmitting station, wherein said intermediate station comprises:

a converter circuit adapted to electronically receive said transmitted information and to convert said transmission to electronic form if said transmitted information is not initially in electronic form; and

a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location.

References

The references relied on by the Examiner are as follows:

Kunigami	5,508,817	Apr. 16, 1996
Maxwell	5,805,810	Sep. 8, 1998
Albal	5,826,034	Oct. 20, 1998
Berkowitz et al. (Berkowitz)	5,903,877	May 11, 1999

Rejections At Issue

Claims 57-66, 70-74, and 90 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Albal and Kunigami and Berkowitz.

Claims 67-69 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Albal and Kunigami and Berkowitz and Maxwell.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated ***infra***, we reverse the Examiner's rejection of claims 57-74 and 90 under 35 U.S.C. § 103.

I. Whether the Rejection of Claims 57-66, 70-74, and 90 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 57-66, 70-74, and 90. Accordingly, we reverse.

---

[1]Appellants filed an appeal brief on August 16, 2001. The Examiner mailed out an Examiner's Answer on March 11, 2003 fully replacing the prior Examiner's Answers mailed November 7, 2001 and August 13, 2002.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 57, Appellants argue at page 6 of the brief, that "Kunigami does not teach or suggest an intermediate location comprising a reproducing circuit adapted to reproduce . . . information . . . in human readable form." The Examiner responds at page 13 of the answer, "[t]he Examiner agrees . . . [h]owever, it would have been inherent in the system of Kunigami to display the e-mail on the display of terminal 3a."

We do not agree with the Examiner. While it might be argued that it is obvious in the extreme to display a transmitted e-mail, we find that it is not "inherent" to do so. Further, while it might be argued that it is obvious to add an intermediate display to the storage unit (11) of Kunigami's figure 1, we do not find that terminal 3a is such an "intermediate" display as required by claim 57. We find that the Examiner has not met his initial burden of establishing a ***prima facie*** case of obviousness, and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

We note that we found none of Appellants' other arguments on pages 5-17 of the brief to be persuasive. For example, the argument at page 9-10 with regard to the motivation to combine Albal and Kunigami, is not persuasive. We find that Kunigami's fee payment processing (see column 4, lines 18-20) and Albal's explicitly stated desire to "ensure that the delivery is effected

in a cost effective and efficient manner," (see column 2, lines 35-36) provide sufficient motivation to combine these references.

II. Whether the Rejection of Claims 67-69 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 67-69. Accordingly, we reverse.

With respect to dependent claims 67-69, we note that the Examiner has relied on the Martin reference solely to teach "transmitting and acknowledgment" [answer, page 8, last line]. The Martin reference in combination with the Albal and Kunigami and Berkowitz fails to cure the deficiencies of Albal and Kunigami and Berkowitz noted above with respect to claim 57. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Other Issues

Claim 62 erroneously reads "A method," while claim 61 from which it depends reads "A system." We recommend that the Examiner require correction of this minor error.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 57-74 and 90.

REVERSED

JOSEPH L. DIXON)
Administrative Patent Judge)
)
)
)
ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)
)
)
ALLEN R. MACDONALD)
Administrative Patent Judge)

ARM/lbg

Appeal No. 2004-0416
Application No. 08/953,477

DALLAS OFFICE OF FULBRIGHT
& JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784